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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,032	07/21/2000	Leslie Gary Graf	27795-00018	4059

7590 12/19/2003

Jenkins & Gilchrist  
1445 Ross Avenue, Suite 3200  
Dallas, TX 75202

EXAMINER

ORGAD, EDAN

ART UNIT	PAPER NUMBER
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2684

12

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/621,032

Applicant(s)

GRAF ET AL.

Examiner

Edan Orgad

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-12 and 37-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-12,37-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 7, 10-12, 37-40, 42, 44-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Sawyer (6,134,438).

Regarding claim 1, Sawyer teaches a method of negotiating operating capabilities in a telecommunications system including at least one mobile station, the method comprising: receiving a first list of operating capabilities for a mobile station at a first node upstream of and associated with the mobile station wherein the list is received prior to setting up a call with the mobile station (col. 4, lines 50-54), storing the operating capabilities at the first node, receiving a second list of operating capabilities from a second node, when the second node is attempting to set up a call with the mobile station (col. 4, lines 53-55), comparing the second list to the first list to negotiate agreed-upon operating capabilities between the second node and the mobile station (col. 4, lines 55-67).

Regarding claim 7, Sawyer teaches the selecting the agreed-upon operating capabilities based on operating capabilities that are in common on both lists (col. 4, lines 55-59).

Regarding claim 10, Sawyer teaches the second node is any one of a mobile station, a terminal device or a node network element (col. 7, lines 14-42).

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Regarding claim 11, teaches the first node is any one of a MSC, a VLR, a HLR or a GMSC (col. 7, lines 14-42).

Regarding claim 12, teaches the second node is a MSC, VLR, HLR or a GMSC (col. 7, lines 14-42).

Regarding claims 37 and 44, Sawyer teaches a method for communicating device operating capabilities between a first mobile station and a second mobile station, wherein the first mobile station is served by a first switch node, wherein the first switch node is associated with a storage means, the method comprising: receiving data indicating the device operating capabilities associated with the first mobile station (col. 4, lines 50-54), wherein the data is communicated without establishing a call connection between the first mobile station and the first switch node; storing the communicated data within the storage means; receiving a call setup message from the first mobile station to establish an outgoing call connection towards the second mobile station; retrieving the stored data within the storage means (col. 4, lines 53-55); and including the retrieved data within the outgoing call setup message to allow the data to be reviewed by a second switch node serving the second mobile station for device compatibility (col. 4, lines 55-67).

Regarding claims 38 and 45, Sawyer teaches the storing is performed by a Visitor Location Register (col. 7, lines 24-27).

Regarding claims 39 and 46, Sawyer teaches the reviewing by the second switch is performed by a Gateway Mobile Switching Center (GMSC) serving the second mobile station (col. 7, lines 14-41).

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Regarding claims 40 and 47, Sawyer teaches the reviewing by the second switch is performed by a Mobile Switching Center (MSC) serving the second mobile station (col. 7, lines 14-41).

Regarding claims 42 and 49, Sawyer teaches the outgoing call setup message is an Initial Address Message (col. 4, lines 3-20).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 41 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawyer (6,134,438).

Regarding claims 2, 41 and 48, Sawyer fails to specifically disclose the message is a location update message. However, official notice is taken that location update messages are very well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a location update message along with Sawyer's existing message protocol in order to provide the switching center with further accuracy in case a handover was needed due to a weak signal of interference.

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Claims 8, 43 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawyer (6,134,438) in view of Laiho (6,522,655).

Regarding claims 8, 43 and 50, Sawyer fails to specifically disclose the operating capabilities include codecs. However, in the same field of endeavor, Laiho teaches operating capabilities including codecs (col. 6; line 56- col. 7 line 14). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include operating capabilities including codecs with Sawyer's invention in order to better manage calls in the interintermediate nodes.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sawyer (6,134,438) in view of Cooper (6,321,079).

Regarding claim 9, Sawyer fails to specifically disclose the operating capabilities include security algorithms. However, in the same field of endeavor, Copper teaches operating capabilities including security algorithms (col. 3, lines 11-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include operating capabilities including security algorithms with Sawyer's invention in order to make it difficult for unauthorized parties to make reverse network lock.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

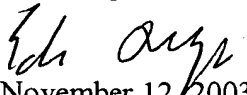
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edan Orgad whose telephone number is 703-305-4223. The examiner can normally be reached on 8:00AM to 5:30PM with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Edan Orgad

  
November 12, 2003

  
**NAY MAUNG**  
**SUPERVISORY PATENT EXAMINER**